

REMARKS

Claims 1-4 and 6-16 are pending in this application. By this Amendment, claims 1, 10 and 11 are amended and claim 5 is canceled. Support for the amendments to the claims may be found, for example, in the claims as originally filed. With respect to the amendments adding a hydrogen atom to Formula (2) in claims 1 and 10, Applicants respectfully submit that this type of amendment is supported because it is common in the art to omit such a hydrogen atom for the sake of conciseness in presenting chemical formulas and would be so recognized by one having ordinary skill in the art. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 11-16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which Applicants regard as the invention. By this Amendment, claim 11 is amended to cancel the broad range. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejections Under 35 U.S.C. §102

A. Seiden

The Office Action rejects claims 1, 2, 4-9 and 11 under 35 U.S.C. §102(b) as being anticipated by GB 1458570 to Seiden et al. ("Seiden") when taken with Applicants' alleged admission at page 11 of the original specification. Applicants respectfully traverse the rejection.

By this Amendment, the subject matter of claim 5 is incorporated into claims 1 and 11 and claim 5 is canceled. Seiden at least fails to teach a ketone group in the main chain as

required by claims 1 and 11. Seiden discloses a process for preparing polyglycerol by heating glycerol under reduced pressure in the presence of sulfuric acid. See col. 1, lines 11-17.

However, Seiden fails to teach or suggest a dehydrogenation reaction which necessarily provides a ketone group in the polyglycerol. In this respect, please note that while the Examples of Seiden, beginning at col. 4, line 40, teach glycerol polymerization by a process involving sulfuric acid to provide polyglycerol mixtures with a high content of linear diglycerol, the compositions listed in the tables on pages 5 and 6 do not necessarily contain ketone groups. Consequently, Seiden does not necessarily provide ketone groups to the polyglycerol as asserted. As is well settled:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Thus, Seiden does not inherently teach the formation of ketone groups as asserted. See Office Action at page 3.

In fact, there is no evidence from the reaction conditions of Seiden implying that ketone groups are formed. The reaction conditions are milder than those disclosed in Applicants' specification. For example, Seiden teaches reactions carried out at 132°C, which have a significantly lower reaction temperature than reactions carried out at 160 °C. Compare the specification, Example 1, at page 30, lines 15-19 to Seiden, Example I, at col. 4, lines 45-47. Moreover, Seiden's reactions involve secondary alcohol groups, which have a lower reactivity than primary alcohol groups, and, thus, at least do not necessarily produce ketone groups in the oxidation reactions disclosed in the Examples of Seiden.

Therefore, Seiden does not anticipate claims 1 and 11. Claims 2, 4 and 6-9 depend from claim 1 and, thus, are also not anticipated by Seiden for at least the same reasons. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Sanderson

The Office Action rejects claims 1, 3, 4, 7, 10 and 11 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,980,514 to Sanderson et al. ("Sanderson"). By this Amendment, the non-rejected subject matter of canceled claim 5 is incorporated into claims 1, 10 and 11, rendering the rejection moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 12-16 under 35 U.S.C. §103(a) as being obvious over Sanderson in view of U.S. Patent Application Publication No. 2003/0213939 to Narayan et al. ("Narayan"). By this Amendment, the non-rejected subject matter of canceled claim 5 is incorporated into claim 11, from which claims 12-16 depend, rendering the rejection moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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